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PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			EXAMINER HAND, MELANIE JO	
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte STEPHEN SOLOMON, MOSHE SHIKE,
and SAM KLEIN

Appeal 2008-004105
Application 10/702,194
Technology Center 3700

Decided:¹ May 19, 2009

Before DONALD E. ADAMS, LORA M. GREEN, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing (reconsideration) of the decision entered December 1, 2008. That decision affirmed the Examiner's rejection of claims 17, 18, and 32-34 under 35 U.S.C. § 103(a).

Appellants' request has been granted to the extent that the decision has been reconsidered, but such request is denied with respect to making any modifications to the decision affirming the examiner's rejection under 35 U.S.C. § 103(a).

DISCUSSION

Appellants contend that "the Board misapprehended Shapiro, and Appellants further submit that FF1 is insufficient to rebut Appellants' contention" (Req. Recons. 4). Appellants contend that "following Shapiro's teachings would lead a person looking for obesity treatments to try regimens that decrease food intake, and avoid regimens that increase food intake" (Req. Recons. 4). Appellants contend that "since Shapiro also teaches that sham feeding increases meal size . . . following Shapiro's teachings would actually lead a person to avoid sham feeding as a treatment of obesity" (Req. Recons. 4).

We have reconsidered the evidence in its entirety. We are unpersuaded by Appellants' arguments because the ordinary artisan would recognize that while the sham feeding of Shapiro might increase food intake, that increased feeding operates "in such a way that the animal eats or drinks without receiving nutritional benefits" (Shapiro 125; Board Dec., FF 5). It is the presence or absence of nutritional benefits, not the amount of food intake, which determines whether the method will function as a treatment for obesity. That is, even if food intake is increased, if calories and nutrition are

not increased, then the method will function to treat obesity. In the context of sham feeding, it is nutritional benefit and calorie intake, not meal size, which determine whether the subject will gain or lose weight.

Shapiro recognizes the centrality of nutritional benefit, noting that “[b]y use of this arrangement which roughly and most ‘dramatically’ mimics the eating-without-calories strategy of bulimia, a host of other variables including dieting . . . can be and have been explored in the exhaustive and recursive way that is characteristic of the research enterprise” (Shapiro 127). In this discussion, Shapiro expressly links dieting, which is a treatment for obesity, with sham feeding (*see* Shapiro 127). Shapiro recognizes that sham feeding is an intervention which reduces nutrition (*see* Board Dec., FF 5, 7) and that Shapiro suggests that interventions which reduce nutrition serve as potential obesity treatments (*see* Board Dec., FF 1). Thus Appellants have not demonstrated that given these two teachings of Shapiro, the ordinary practitioner of ordinary creativity would have found it obvious to employ sham feeding as a treatment for obesity.

SUMMARY

Appellants’ request has been granted to the extent that the decision has been reconsidered, but such request is denied with respect to making any modifications to the decision affirming the examiner’s rejection under 35 U.S.C. § 103(a).

DENIED

Appeal 2008-004105
Application 10/702,194

cdc

PROSKAUER ROSE LLP
PATENT DEPARTMENT
1585 BROADWAY
NEW YORK NY 10036-8299